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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,378	09/26/2003	Thomas DeWitt Smith	11051-0002	6905
22902 7590 07/25/2008 CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005				
EXAMINER				
CLAYTOR, DEIRDRE RENEE				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
07/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/670,378

**Applicant(s)**

SMITH, THOMAS DEWITT

**Examiner**

Renee Claytor

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 7, 9, 17-18, 20-21, 26, 37, 41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 6, 7, 9, 17-18, 20-21, 26, 37, 41 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's response filed on 3/7/2008 has been fully considered. In particular, Applicants present arguments over the 35 USC 103 rejection. Applicants argue that McAtee excludes moisture in his formulation. It is further argued that McAtee only uses a water-in oil composition and does not contemplate an oil-in water composition. Applicants also argue that McAtee uses heating steps in Examples 6-10 in an effort to provide lipid hardness.

In response to the above arguments, it is noted that the primary reference used (Narula) teaches oil-in water emulsions that are comprised of petrolatum and water. While it is understood that McAtee teaches an article that provides conditioning benefits, it is also noted that within the article an emulsion is made and then added to the article. McAtee teaches that the emulsion requires an emulsifier of which includes methyl glucose dioleate as relied upon in the reference. McAtee further teaches that the emulsion is useful for providing conditioning benefits to the skin. Therefore, the emulsion portion of composition of the McAtee et al. reference could be combined with Narula et al. to formulate an emulsion composition to condition the skin. Further, McAtee teaches in Examples 6-10 that heating was performed to provide uniformity and does state that it is for lipid hardness. Also, the same components are taught by McAtee et al. as in the present invention and the melting temperatures of the compounds are a property of the compound and the properties are inseparable. Therefore, the components were used for their emulsification properties in both inventions. It is further noted that McAtee was not used to teach water in the emulsion

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but to teach that conditioning emulsions can be formulated with the same components of the instant invention. Mixing two emulsifiers is not an obvious modification because it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, it has been held that merely changing the order of steps in a multi-step process is not a patentable modification absent a showing of unexpected results. *Ex parte Rubin* 128 USPQ 440 (POBA 1959.)

Accordingly, the rejection is maintained and is given below for Applicant's convenience.

***Claim Rejections – 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7, 9, 17-18, 20-21, 26, 37, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Narula (US Patent 4,788,001) in view of McAtee et al. (US Patent 6,153,208).

Narula teaches methods of making oil-in-water emulsions that are comprised of petrolatum (Col. 3, lines 18-19). Narula teaches that the emulsions are diluted with water (Col. 7, lines 42-47).

Narula does not teach heating the petrolatum up to 80°C, diluting the emulsion with water preheated up to 50°C, the addition of a preservative system (specifically DMDM hydantoin and iodo propynyl butyl carbamate), or the addition of hydrocortisone.

McAtee et al. teaches methods of making compositions with a conditioning emulsion comprised of an oil soluble conditioning agent, including petrolatum (Col. 25, line 58 and Col. 26, lines 13-21) and methyl glucose dioleate as the emulsifier (Col. 30, line 53). Active ingredients include hydrocortisone (meeting the limitation of claims 9, 20, 26-27 and 37-38; Col. 45, line 14 and Col. 48, line 8). Examples 6-10 state that the ingredients of the conditioning emulsion are mixed at between 75-115°C (further meeting the limitation of claims 6 and 17; Col. 54). Other ingredients that can be incorporated into the conditioning emulsion include Glydant Plus (meeting the limitations of claims 7, 21 and 39-41; Col. 47, lines 4-5).

Furthermore, it is obvious to vary and/or optimize the temperature to dilute the emulsion with water at 50°C provided in the composition, according to the guidance provided by McAtee et al., to provide a stable composition. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is also noted that it has been held that merely changing the order of steps in a multi-step process is not a patentable

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modification absent a showing of unexpected results. *Ex parte Rubin* 128 USPQ 440 (POBA 1959).

Accordingly, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In *re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). In the instant case, one would have been motivated to make an absorption base comprised of petrolatum and methyl glucose dioleate because of the teachings of Narula and McAtee et al. that both agent are used as emulsifiers and it would be obvious to a person of ordinary skill in the art to make an absorption base with excellent emulsifying properties.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

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/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617